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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/784,689
Filing Date: 2/23/2004
Applicant(s): Dale M. Schultz
Entitled: TESTING MULTI-BYTE DATA HANDLING
USING MULTI-BYTE EQUIVALENTS TO
SINGLE-BYTE CHARACTERS IN A
TEST STRING
Examiner: Loren B Chauhan
Group Art Unit: 2193
Attorney Docket No.: LOT920040010US1 (7321-043U)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellant's Appeal Brief in support of the Notice of Appeal filed June 18, 2008. As this Appeal Brief has been timely filed within the shortened statutory period of two months from the date of the Notice of Appeal, no extension of time under 37 C.F.R. § 1.136 is required. Notwithstanding, please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Date: August 18, 2008

Respectfully submitted,

/Steven M. Greenberg/
Steven M. Greenberg, Registration No. 44,725
Customer Number 46321

PATENT

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APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed June 18, 2008, wherein Appellant appeals from the Examiner's rejection of claims 1 through 16.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by assignment recorded on February 23, 2004, at Reel 015020, Frame 0492.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1 through 16 are pending in this Application and have been twice rejected. It is from the multiple rejections of claims 1 through 16 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

Claims 1, 2, 5 through 7, 10 through 12 and 14 through 15 were amended in the Amendment filed on December 27, 2007 (the "Amendment") in response to the Non-Final Office Action dated September 24, 2007 (the "Non-Final Office Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER

By reference to paragraph [0017] of Appellant's published specification, Appellant has invented a system, method and apparatus for testing multi-byte data handling in an application under test. In accordance with Appellant's invention, a source string of test data can be converted to a multi-byte string by converting each character in the string to its multi-byte equivalent. Once converted, the multi-byte equivalent version of the source string can be provided as input to an application under test to ensure that not only whether the user interface of the application test can properly render the multi-byte equivalent version of the source string, but also whether the internal logic of the application under test can process, store and retrieve the multi-byte representation of the source string.

With specific reference to claim 1, claim 1 as amended recites a method for testing multi-byte data handling. (Par. [0019]) The method includes converting each single byte native text character of a source string to a multi-byte equivalent including a wide Latin equivalent to produce a multi-byte test string. (Par. [0019]) The method also includes providing the multi-byte test string to a testing tool for use when testing a computer program. (Par. [0018] and Par. [0020])

With specific reference to claim 6, a machine readable storage is recited having stored thereon a computer program for testing multi-byte data handling. The computer program includes a routine set of instructions which when executed by a machine cause the machine to convert each single byte native text character of a source string to a multi-byte equivalent including a wide Latin equivalent to produce a multi-byte test string. (Par. [0019]) Thereafter, the multi-byte test string is provided to a testing tool for use when testing a computer program. (Par. [0018] and Par. [0020])

With respect to claim 11, a method for testing multi-byte data handling is provided. The method includes first loading a first single-byte character in a test string and adding a base value to the loaded character to convert the character to a multi-byte equivalent character including a wide Latin equivalent. (Par. [0019]) Thereafter, the multi-byte equivalent character is inserted into a result string at a position in the result string equivalent to a corresponding position in the test string. . (Par. [0019]) Then, a next single byte character is loaded in the test string and the adding, inserting and second loading steps are repeated for each remaining character in the test string. (Par. [0020])

With respect to claim 14, a machine readable storage is recited having stored thereon a computer program for testing multi-byte data handling. The computer program includes a routine set of instructions which when executed by a machine cause the machine to first load a first single-byte character in a test string and to add a base value to the loaded character to convert the character to a multi-byte equivalent character including a wide Latin equivalent. (Par. [0019]) Thereafter, the multi-byte equivalent character is inserted into a result string at a position in the result string equivalent to a corresponding position in the test string. (Par. [0019]) Then, a next single byte character is loaded in the test string and the adding, inserting and second loading steps are repeated for each remaining character in the test string. (Par. [0020])

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 through 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,507,812 to Meade.

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1 THROUGH 16 UNDER 35 U.S.C. § 103.

For convenience of the Honorable Board in addressing the rejections, claim 2 through 5 stand or fall together with claim 1, claims 7 through 10 stand or fall together with claim 6, claims 12 and 13 stand or fall together with claim 11, and claims 15 and 16 stand or fall together with claim 14.

Appellant's Claim 1 (and comparably, Claims 6, 11 and 14) refers to a method for testing multi-byte data handling. Exemplary Claim 1 recites as follows:

1. A method for testing multi-byte data handling comprising the steps of:
 - converting each single byte native text character of a source string to a multi-byte equivalent comprising a wide Latin equivalent to produce a multi-byte test string; and,
 - providing said multi-byte test string to a testing tool for use when testing a computer program.

Integral to Claims 1 and 6 is the conversion of a single byte native text character of a source string to a multi-byte equivalent comprising a wide Latin equivalent to produce a multi-byte test string.

In the Amendment, Appellant expressly argued that Meade wholly lacked any teaching directed to a wide Latin equivalent. Specifically, Appellant stated,

In rejecting claims 2 and 7 the Examiner further relies upon column 2, lines 61 through 62 and column 8, lines 23 through 29 of Meade to address the limitation "wide Latin equivalent". Column 2, lines 61 through 62 state in its entirety,

enclosed with brackets, i.e., []. This mock translation data is stored in localization files and displayed in a software.

Likewise, column 8, lines 23 through 29 state in its entirety,

the localization files (step 800). Each entry in the file is then mock translated by converting each single-byte character to its double-byte, double-width equivalent (step 810). Finally, the translated entries are written back to the localization files (step 720). Now, when the software application is run for testing, the mock-translated, double-wide text will appear in place of the original text.

Obviously, there is no mention of "wide Latin equivalent" or any such synonymous term.

Examiner responded to Appellant's arguments¹ on page 3 of the Final Office Action dated March 18, 2008 (the "Final Office Action") in which the Examiner stated

Meade does not explicitly teach multi-byte equivalent is a wide Latin equivalent. However, Meade teaches mock translation file is created by converting single-byte character (col. 8, lines 23-29) to its double or multi-byte equivalent (col. 7, lines 7-9) and can be displayed in place of the English or foreign language (col. 2, lines 61-63) thus teaches multi-byte equivalent is a wide Latin equivalent.

¹ Ironically, Examiner rendered the Final Office Action "Final" because Appellant's amendments "necessitated a new ground of rejection". However, in that the entirety of Examiner's "new" ground of rejection is merely a rehash of the exact same portion of Meade previously cited, Examiner only has changed the nature of the rejection from anticipatory grounds to obviousness grounds. Clearly, Examiner's behavior in this regard is plain unacceptable and reflects poorly on the integrity of the Examining Corps in asserting that a new examination was somehow performed in light of amended claims when in fact, no new examination was performed.

Remarkably, Examiner contradicts himself in stating in consecutive paragraphs first "Meade does not explicitly teach ... wide Latin equivalent" and subsequently, "[Meade] thus teaches multi-byte-equivalent is a wide Latin equivalent". Yet, Examiner provides no evidentiary support for the presence of "Wide Latin Equivalent" in Meade or any other cited reference nor has Examiner provided a proper claim construction for the term Wide Latin Equivalent.

Even still, Examiner appears to attempt to argue that it would be obvious to the skilled artisan that the multi-byte equivalent is a "wide Latin equivalent", however, Examiner has not conducted the relevant analysis to arrive at the foregoing conclusion. In this regard, obviousness is a legal conclusion based on underlying factual determinations of four general types, all of which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the level of skill in the art; (3), the differences between the claimed subject matter and the prior art; and (4) any objective indicia of nonobviousness.² Appellant's position is that the Examiner has not properly established the underlying facts regarding (1) the scope and content of the prior art and (3) the differences between the claimed invention and the prior art. Thus, the Examiner has improperly arrived at the legal conclusion that the claimed invention is obvious based upon Meade.

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,³ a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit,

² See KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007); Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ2d 459, 467 (1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1594 (Fed. Cir. 1987).

³ 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

and the Supreme Court) can only review what has been written in the record; and therefore, the **Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.**

However, as will be apparent from page 3 of the Final Office Action, essentially, the Examiner is placing the burden on Appellants to establish that Meade does not disclose the claimed element of "Wide Latin Equivalent" based upon Appellant's interpretation of the claims and Appellant's comparison of the claims with the applied prior art. However, this shifting of burden, from the Examiner to Appellant, is premature since the Examiner has not discharged the initial burden of providing a *prima facie* case of obviousness. Appellants also note that any continuing disagreement between Appellants and the Examiner as to whether or not a particular claimed feature is disclosed by Meade is a direct result of a lack of specificity by the Examiner in the statement of the rejection--e.g. where a teaching of Wide Latin Equivalent can be found.

Based upon Appellants arguments and the law cited herein, Appellants position is that the Examiner has failed meet the initial burden of establishing a *prima facie* case of obviousness. As such, until that *prima facie* case has been made, Appellants have no burden to point out the differences between the applied prior art and the claimed invention. Referring to the unpublished opinion of Ex parte Pryor⁴, the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a *prima facie* case of obviousness. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements

⁴ Appeal No. 1997-2981.

between the instant claims and the applied reference, fails to clearly make out a prima facie case of [obviousness] (emphasis in original).

Notwithstanding that the burden of pointing out the differences between the applied prior art and the claimed invention has not been shifted to Appellant, Appellant presented arguments as to the differences between Meade and the claimed invention in the Amendment to which the Examiner agreed on page 3 of the Final Office Action.

Based upon the foregoing, Appellant respectfully submit that the Examiner's rejections under 35 U.S.C. § 103(a) for obviousness based upon the applied prior art are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103(a).

Date: August 18, 2008

Respectfully submitted,

/Steven M. Greenberg/

Steven M. Greenberg

Registration No. 44,725

Customer Number 46321

VIII. CLAIMS APPENDIX

1. (Previously Amended) A method for testing multi-byte data handling comprising the steps of:

converting each single byte native text character of a source string to a multi-byte equivalent comprising a wide Latin equivalent to produce a multi-byte test string; and,
providing said multi-byte test string to a testing tool for use when testing a computer program.

2. (Previously Amended) The method of claim 1, wherein said wide Latin equivalent comprises Unicode characters ranging from U+FF21 through U+FF5A.

3. (Original) The method of claim 1, wherein said converting step comprises the steps of:

for each said single byte native text character, determining whether said character falls within a range of alphanumeric characters; and,

for each said single byte native character, converting said character to a multi-byte equivalent to produce a multi-byte test string only if said character falls within said range.

4. (Original) The method of claim 2, wherein said converting step comprises the steps of:

for each said single byte native text character, determining whether said character falls within a range of alphanumeric characters; and,

for each said single byte native character, converting said character to a multi-byte equivalent to produce a multi-byte test string only if said character falls within said range.

5. (Previously Amended) The method of claim 1, wherein said converting step comprises the step of adding a fixed integer value to each said character to produce said wide Latin equivalent.

6. (Previously Amended) A machine readable storage having stored thereon a computer program for testing multi-byte data handling, the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of:

converting each single byte native text character of a source string to a multi-byte equivalent comprising a wide Latin equivalent to produce a multi-byte test string; and,

providing said multi-byte test string to a testing tool for use when testing a computer program.

7. (Previously Amended) The machine readable storage of claim 6, wherein said wide Latin equivalent comprises Unicode characters ranging from U+FF21 through U+FF5A.

8. (Original) The machine readable storage of claim 6, wherein said converting step comprises the steps of:

for each said single byte native text character, determining whether said character falls within a range of alphanumeric characters; and,

for each said single byte native character, converting said character to a multi-byte equivalent to produce a multi-byte test string only if said character falls within said range.

9. (Original) The machine readable storage of claim 7, wherein said converting step comprises the steps of:

for each said single byte native text character, determining whether said character falls within a range of alphanumeric characters; and,

for each said single byte native character, converting said character to a multi-byte equivalent to produce a multi-byte test string only if said character falls within said range.

10. (Previously Amended) The machine readable storage of claim 6, wherein said converting step comprises the step of adding a fixed integer value to each said character to produce said wide Latin equivalent.

11. (Previously Amended) A method for testing multi-byte data handling comprising the steps of:

first loading a first single-byte character in a test string;

adding a base value to said loaded character to convert said character to a multi-byte equivalent character comprising a wide Latin equivalent;

inserting said multi-byte equivalent character into a result string at a position in said result string equivalent to a corresponding position in said test string;

second loading a next single byte character in said test string; and,

repeating said adding, inserting and second loading steps for each remaining character in said test string.

12. (Previously Amended) The method of claim 11, wherein said adding step comprises the step of adding a base value to said loaded character to convert said character to a wide Latin equivalent comprising Unicode characters ranging from U+FF21 through U+FF5A.

13. (Original) The method of claim 11, further comprising the step of performing said adding step only if said loaded character is an alphanumeric character.

14. (Previously Amended) A machine readable storage having stored thereon a computer program for testing multi-byte data handling, the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of:

first loading a first single-byte character in a test string; adding a base value to said loaded character to convert said character to a multi-byte equivalent character comprising a wide Latin equivalent;

inserting said multi-byte equivalent character into a result string at a position in said result string equivalent to a corresponding position in said test string;

second loading a next single byte character in said test string; and,

repeating said adding, inserting and second loading steps for each remaining character in said test string.

15. (Previously Amended) The machine readable storage of claim 14, wherein said adding step comprises the step of adding a base value to said loaded character to convert said character to a wide Latin equivalent comprising Unicode characters ranging from U+FF21 through U+FF5A.

16. (Original) The machine readable storage of claim 14, further comprising the step of performing said adding step only if said loaded character is an alphanumeric character.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.